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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/627,252

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Edward B. Knudson

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ROPES & GRAY LLP

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EXAMINER

STOKELY-COLLINS, JASMINE N

ART UNIT

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2623

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DELIVERY MODE

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/627,252	Applicant(s) KNUDSON ET AL.	
	Examiner JASMINE STOKELY-COLLINS	Art Unit 2623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 December 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>12/10/2007</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments, filed on 12/10/2007, with respect to the rejection(s) of claim(s) 1-15 under 35 USC § 103 have been fully considered and are persuasive.

Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of newly found prior art references.

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1-15 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-15 of U.S. Patent No. 6,275,648 B1.

Although the conflicting claims are not identical, they are not patentably distinct from

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each other because the patent claims anticipate every claim claimed in the instant application.

Claim 1 of application 10/627252 is anticipated by claim 1 of U.S. Patent No. 6,275,648 B1.

Claim 2 of application 10/627252 corresponds to claim 2 of U.S. Patent No. 6,275,648 B1.

Claim 3 of application 10/627252 corresponds to claim 3 of U.S. Patent No. 6,275,648 B1.

Claim 4 of application 10/627252 corresponds to claim 4 of U.S. Patent No. 6,275,648 B1.

Claim 5 of application 10/627252 corresponds to claim 5 of U.S. Patent No. 6,275,648 B1.

Claim 6 of application 10/627252 is anticipated by claim 11 of U.S. Patent No. 6,275,648 B1.

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Claim 7 of application 10/627252 corresponds to claim 12 of U.S. Patent No. 6,275,648 B1.

Claim 8 of application 10/627252 corresponds to claim 13 of U.S. Patent No. 6,275,648 B1.

Claim 9 of application 10/627252 corresponds to claim 14 of U.S. Patent No. 6,275,648 B1.

Claim 10 of application 10/627252 corresponds to claim 15 of U.S. Patent No. 6,275,648 B1.

Claim 11 of application 10/627252 is anticipated by claim 6 of U.S. Patent No. 6,275,648 B1.

Claim 12 of application 10/627252 corresponds to claim 7 of U.S. Patent No. 6,275,648 B1.

Claim 13 of application 10/627252 corresponds to claim 8 of U.S. Patent No. 6,275,648 B1.

Claim 14 of application 10/627252 corresponds to claim 9 of U.S. Patent No. 6,275,648 B1.

Claim 15 of application 10/627252 corresponds to claim 10 of U.S. Patent No. 6,275,648 B1.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-3, 5-8, 10-13, and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sato (US 6,408,435 B1) in view of Young et al (US 5,353,121), and further in view of Choi (US 5,285,265).

Regarding claim 1, Sato teaches an interactive program guide system (tabulated information on broadcasting programs, abstract) including user equipment (figure 1 element 21: personal computer with WWW browser) with which an interactive television program guide is provided (column 5 lines 8-15) and which includes a video recorder (figure 1 elements 11 and 13: VTR and mini disc player/recorder) and a television (figure 1 element 14: TV receiver), comprising:

means for receiving television program guide information for use in the interactive television program guide (column 5 lines 8-15); and means for selecting a program for recording from the interactive television program guide (column 5 lines 15-25).

Regarding limitation “means for determining whether the video recorder and television are a combined unit”, Sato teaches means for determining the types of devices connected to an audio/visual system (column 7 lines 14-30).

Sato does not teach a combined television and video recorder unit. Sato also does not teach means for displaying a message prior to recording the selected program when the video recorder and television are a combined unit that informs the user that recording is to begin and asks the user whether to continue with recording.

Young teaches an interactive program guide system that can include a combined television and video recorder unit (column 18 lines 26-32). It would have been obvious to one of ordinary skill in the art at the time the invention was made to include the combined television and video recorder unit taught by Young in the multitude of registered devices taught by Sato for the benefit of accommodating a more comprehensive array of available audio/visual devices.

Choi teaches means for displaying a message prior to recording a program (column 4 lines 4-11-36, figure 3) that informs the user that recording is to begin and asks the user whether to continue with recording (although the screen does not display a “would you like to continue recording” message, it is

implied. The purpose of the screen is to give a user the opportunity to cancel the scheduled recording, as evidenced by column 1 lines 42-51). It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate Choi's teaching of a recording confirmation screen with the interactive program guide and TV/VCR combo taught by Sato in view of Young for the benefit of giving the user greater control over recording functions.

Regarding claim 2, when read in light of claim 1, Choi further teaches means for cancelling the recording of the selected program when the user chooses to not continue with recording in response to the message (column 1 lines 42-51).

Regarding claim 3, when read in light of claim 1, Sato further teaches means for receiving a plurality of television channels (figure 1 elements 17 and 18: antennas for receiving VHF/UHF and satellite broadcasts). Young further teaches means for tuning to the channel for the selected program and directing the video recorder to record the selected program (column 19 lines 1-11). The combination of Sato in view of Young and Choi result in this happening when the user chooses to continue with recording in response to the message, as discussed in claim 1.

Regarding claim 5, when read in light of claim 1, Sato further teaches means for receiving a plurality of television channels (figure 1 elements 17 and 18: antennas for receiving VHF/UHF and satellite broadcasts); Young further teaches means for tuning to the channel for the selected program, turning on the video recorder, and directing the video recorder to record the selected program (column 19 lines 1-11).

Choi teaches the recording function occurs when the user does not respond to the message (column 3 lines 48-54, where claim 11 "enabling user disablement of said pre-programmed recording operation" implies that recording will continue as scheduled unless disabled by the user).

Regarding claim 6, Sato teaches a method for using an interactive program guide system (tabulated information on broadcasting programs, abstract) including user equipment (figure 1 element 21: personal computer with WWW browser) with which an interactive television program guide is provided (column 5 lines 8-15) and which includes a video recorder (figure 1 elements 11 and 13: VTR and mini disc player/recorder) and a television (figure 1 element 14: TV receiver), comprising:
receiving television program guide information for use in the interactive television program guide (column 5 lines 8-15); and
selecting a program for recording from the interactive television program guide (column 5 lines 15-25).

Regarding limitation “determining whether the video recorder and television are a combined unit”, Sato teaches means for determining the types of devices connected to an audio/visual system (column 7 lines 14-30).

Sato does not teach a combined television and video recorder unit. Sato also does not teach displaying a message prior to recording the selected program when the video recorder and television are a combined unit that informs the user that recording is to begin and asks the user whether to continue with recording.

Young teaches an interactive program guide system that can include a combined television and video recorder unit (column 18 lines 26-32).

Choi teaches displaying a message prior to recording a program (column 4 lines 4-11-36, figure 3) that informs the user that recording is to begin and asks the user whether to continue with recording (although the screen does not display a “would you like to continue recording” message, it is implied. The purpose of the screen is to give a user the opportunity to cancel the scheduled recording, as evidenced by column 1 lines 42-51).

Regarding claim 7, please see analysis of claim 2.

Regarding claim 8, please see analysis of claim 3.

Regarding claim 10, please see analysis of claim 5.

Regarding claim 11, please see analysis of claim 1. The claimed circuitry configured to perform the functions of claim 1 is inherent.

Regarding claim 12, please see analysis of claim 2.

Regarding claim 13, please see analysis of claim 3.

Regarding claim 15, please see analysis of claim 5.

6. Claims 4, 9, and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sato (US 6,408,435 B1) in view of Young et al (US 5,353,121) and Choi (US 5,285,265), and further in view of Roop et al (US 5,619,274).

Regarding claim 4, when read in light of claim 3, Sato in view of Young and Choi teaches the interactive program guide system defined in claim 3 further comprising means to continue with recording in response to a message. Sato in view of Young and Choi does not teach means for recording the selected program without directing the video recorder to turn on.

Roop teaches means for recording the selected program without directing the video recorder to turn on (column 15 lines 36-48). When combined with the

teachings of Sato in view of Young and Choi, this results in the recording process occurring when the user chooses to continue with recording in response to the message. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Roop with the TV/VCR recording method taught by Sato in view of Young and Choi for the benefit of not inadvertently preventing recording in the situation where a VCR is already turned on at the scheduled recording time.

Regarding claim 9, please see analysis of claim 4.

Regarding claim 14, please see analysis of claim 4.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JASMINE STOKELY-COLLINS whose telephone number is (571) 270-3459. The examiner can normally be reached on M-Th 9:30-5:00 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Koenig can be reached on (571) 272-7296. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jasmine Stokely-Collins/
Examiner, Art Unit 2623

/Andrew Y Koenig/
Supervisory Patent Examiner, Art Unit 2623